# REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1-12, 14-18, and 20-27 will have been canceled, claims 13 and 19 will have been amended, and claims 28-45 will have been submitted for consideration by the Examiner. In view of the above, Applicants respectfully request reconsideration of the outstanding objections and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action, for the acceptance of the drawings filed in the present application on April 19, 2001, and for the acknowledgment of Applicants' Claim for Priority under 35 U.S.C. § 119 and receipt of the certified copy of the priority document, in the Official Action.

Applicants further note with appreciation the Examiner's acknowledgment of Applicants' Information Disclosure Statement filed in the present application on July 15, 2003 by the return of the initialed and signed PTO-1449 Form, as well as for consideration of the documents cited in the Information Disclosure Statement.

Turning to the merits of the action, the Examiner has objected to Fig. 3 because of a typographical error. By the present amendment, Applicants have eliminated the typographical error and have submitted a replacement page with the error corrected therein. Thus, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner has objected to Figs. 6, 8, and 9 because of a typographical error. By the present amendment, Applicants have amended the specification to define the phrase "cellular phone mail address" as including "an e-mail address of a user of the

cellular phone". Thus, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner has objected to the Abstract of the Disclosure because of informalities. By the present amendment, Applicants have amended the Abstract of the Disclosure to correct the phrase "email address of a cellular phone". Thus, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner has objected to the specification because of informalities. By the present amendment, Applicants have amended the specification to define the phrase "cellular phone mail address" as including "an e-mail address of a user of the cellular phone". Thus, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner has objected to claims 6 and 11 because of informalities. By the present amendment, Applicants have canceled claims 6 and 11 without prejudice or disclaimer. Thus, Applicants respectfully submit that the objections have been rendered moot.

The Examiner has rejected claims 1, 3, 23, and 25 under 35 U.S.C § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. By the present amendment, Applicants have canceled claims 1, 3, 23, and 25 without prejudice and disclaimer. Thus, Applicants respectfully submit that the objections have been rendered moot.

The Examiner has objected to claims 13 and 19 as being dependent upon a rejected base claim. By the present amendment, Applicants have amended claims 13 and 19 into independent form including all of the limitations of the base claim and any intervening claims while also improving the language of the claims. Thus, Applicants

respectfully request that the Examiner withdraw the objection and indicate the allowability of these claims.

The Examiner has rejected claims 1-10, 14-18, and 20-27 under 35 U.S.C § 102(e) as being anticipated by ELDRIDGE et al. (U.S. Patent No. 6,430,601).

The Examiner has rejected claims 11 and 12 under 35 U.S.C § 103(a) as being unpatentable ELDRIDGE et al. (U.S. Patent No. 6,430,601) in view of SINGHAL (U.S. Patent No. 6,256,666).

As noted above, Applicants have canceled the rejected claims, have amended claims 13 and 19, and have submitted new claims 28-45 for consideration. Applicants respectfully traverse the above rejection based on newly added claims 28-45 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The newly added claims merely clarify the subject matter recited in the canceled claims, but do not narrow the scope of the claims.

Applicants' new claims 28-41 relate to a document transmission apparatus which comprises a LAN controller configured to be connected to a mail server. The mail server stores an e-mail directed to a predetermined user. The LAN controller is connected to a cellular phone of the predetermined user via an Internet. The document transmission apparatus comprises a first memory which stores an e-mail address of the predetermined user of the cellular phone associated with a local mail account of the predetermined user. The document transmission apparatus comprises a second memory which stores printer addresses of a plurality of printers. The document transmission apparatus is able to access the plurality of the printers, based on the printer addresses. The document transmission apparatus comprises a controller which

accesses the mail server via the LAN, checks for arrival of the e-mail directed to the predetermined user by logging onto the local mail account of the predetermined user, searches the first memory for the e-mail address of the predetermined user of the cellular phone when the e-mail directed to the predetermined user is stored in the mail server, and transmits a notification message to the mail address of the predetermined user of the cellular phone via the Internet. The notification message notifies the predetermined user of the cellular phone of the arrival of the e-mail directed to the predetermined user. The controller transmits, to the cellular phone, information regarding the plurality of the printers that the document transmission apparatus can access, receives, from the cellular phone, an indication of a selection of one printer from the plurality of printers, and transmits, to the selected printer, the e-mail directed to the predetermined user, based on a printer address of the selected printer stored in the second memory. Then, the transmitted e-mail can be printed by the selected printer. Claim 42 recites a related method.

Applicants' new claims 43-44 relate to a document transmission apparatus which comprises a LAN controller configured to be connected to a cellular phone of a predetermined user via an Internet. The document transmission apparatus comprises a memory which stores printer addresses of a plurality of printers. The document transmission apparatus is able to access the plurality of printers, based on the printer addresses. The document transmission apparatus comprises a controller which transmits, to the cellular phone, first screen data configured to instruct the predetermined user of the cellular phone to input a URL, receives, from the cellular phone, the screen data including the input URL, and accesses a Web server based on

the input URL, to obtain, from the accessed Web server, home page information corresponding to the input URL. The controller transmits, to the cellular phone, second screen data configured to display information regarding the plurality of printers that the document transmission apparatus can access, receives, from the cellular phone, an indication of a selection of one printer from the plurality of printers, and transmits, to the selected printer, the obtained home page information, based on a printer address of the selected printer stored in the memory. Then, the obtained home page information can be printed by the selected printer. Claim 45 recites a related method.

In contrast, ELDRIDGE et al. relates to a system for alerting users of mobile computing devices of updates to documents stored in a shared document repository using document tokens. More particularly, mobile computing devices 118 store document tokens. The document tokens identify documents stored on the shared document repository. The documents are originally created using scanner 110 or workstations 108 and can include video or audio (col. 6, lines 56-67, col. 7, lines 1-3). When the token-enabled server 126 determines that a document element has been modified, the token-enabled server 126 automatically alerts users of mobile computing devices 118 with a paging message containing a document token of the identified modification. Users of mobile computing devices 118 are automatically notified of changes to documents stored on the shared document repository (col. 7, lines 4-24). When users of mobile computing devices 118 receive the paging message, the users of mobile computing device 118 can reproduce the modified document by transmitting, to printer 102, an appropriate document service request containing the document tokens. The users of mobile computing devices 118 are capable of reproducing the modified

devices 118 (col. 8, lines 25-37). In response to a print request from a mobile computing device, the token-enabled server 126 recovers a document identified by a selected document token and directs the identified document to be printed on a selected printer (col. 9, lines 17-30). The mobile computing devices 118 transmit a request for a list of available transaction services for the users. When the mobile computing devices 118 receives the list of available services, the users select the print command button while selecting print service (col. 10, lines 54-67).

However, the token-enabled server 126 does not disclose a LAN controller which is connected to a mail server, the mail server storing an e-mail directed to a predetermined user, since the shared document repository of ELDRIDGE et al. stores documents including video or audio but does not store an e-mail directed to a predetermined user of a cellular phone.

The token-enabled server 126 also does not disclose a first memory which stores an e-mail address of the predetermined user of the cellular phone associated with a local mail account of the predetermined user, since ELDRIDGE et al. does not contain any disclosure regarding a local mail account of the predetermined user.

The token-enabled server 126 further does not disclose a controller which checks for arrival of the e-mail directed to the predetermined user by logging onto the local mail account of the predetermined user, since the token-enabled server 126 checks whether a document stored in the shared document repository has been modified.

The token-enabled server 126 does not comprise a controller which transmits a notification message to the e-mail address of the predetermined user of the cellular phone via the Internet, the notification message notifying the predetermined user of the cellular phone of the arrival of the e-mail directed to the predetermined user, since the token-enabled server 126 transmits, to the mobile computing device, a paging message, the paging message notifying users of mobile computing devices of changes to documents stored in the shared document repository.

Thus, ELDRIDGE et al. does not comply with recitations of the pending claims 28-41 and 42, and the pending claims 28-41 and 42 are clearly distinguished over ELDRIDGE et al.

Further, the token-enabled server 126 does not comprise a controller which transmits, to the cellular phone, first screen data configured to instruct the predetermined user of the cellular phone to input a URL, since ELDRIDGE et al. merely transmits the paging message to the mobile computing device.

The token-enabled server 126 also does not comprise a controller which receives, from the cellular phone, the screen data including the input URL, accesses a Web server based on the input URL, and obtains, from the accessed Web server, home page information corresponding to the input URL, since ELDRIDGE et al. does not contain any disclosure about a URL.

The token-enabled server 126 further does not comprise a controller which transmits, to the selected printer, the obtained home page information, based on a printer address of the selected printer stored in the memory, the obtained home page

information being printed by the selected printer, since ELDRIDGE et al. does not disclose printing obtained home page information.

Thus, ELDRIDGE et al. does not comply with recitations of the pending claims 43-45, and the pending claims 43-45 are clearly distinguished over ELDRIDGE et al.

Therefore, it is respectfully submitted that the features recited in Applicants' newly submitted claims 28-45 are not disclosed in ELDRIDGE et al. cited by the Examiner.

SINGHAL relates to a method for accessing e-mail attachments stored on a server from a remote, low-capability client device. Client devices can remotely access and manipulate e-mail attachments by generating Attachment Control Messages (ACM). The ACM is encapsulated within e-mail messages generated by the client device and sent over the Mobile Access Network (col. 5, lines 8-16). The Mobile Access Gateway 520 is extended to provide a Mobile Message Processor 550 (MMP). The MMP 550 intercepts all e-mail messages sent from the client device and determines whether the message is the ACM. When the message is the ACM, the MMP executes the instructions contained within the message (col. 5, lines 17-25). The ACM contains instructions for manipulating the attachments associated with a particular piece of delivered e-mail. For example, the ACM can instruct the MMP 550 to print the attachment on a printer (col. 5, lines 40-57). When the MMP 550 receives a message generated by a client device, the MMP 550 detects whether the message is an Attachment Control Message. If so, the MMP 550 performs the demanded actions. For example, the MMP 550 retrieves the target message from the e-mail server 500, according to the Message ID contained in the ACM (col. 6, lines 21-33). The MMP 550

selects the appropriate Connector for the viewer application (col. 7, lines 31-48). When a viewer application has been launched, additional commands can be passed to remotely control the viewer (e.g., make it print the document to a designated printer or the network) (col. 7, lines 49-57).

However, the MMP 550 of SINGHAL does not include a first memory which stores an e-mail address of the predetermined user of the cellular phone associated with a local mail account of the predetermined user.

The MMP 550 also does not comprise a controller which checks an arrival of the e-mail directed to the predetermined user by logging onto the local mail account of the predetermined user, since the MMP 550 merely checks all e-mail messages sent from the client device (e.g., cellular phone) to determine which is the AMC.

The MMP 550 further does not comprise a controller which transmits a notification message to the e-mail address of the predetermined user of the cellular phone via the Internet, the notification message notifying the predetermined user of the cellular phone of the arrival of the e-mail directed to the predetermined user, since the MMP 550 retrieves the target message from the e-mail server, based on the instruction contained in the ACM. The client device (e.g., cellular phone) transmits the ACM to the MMP 550, but the MMP 550 does not transmit the ACM to the client device.

Thus, SINGHAL does not comply with recitations of the pending claims 28-41 and 42, and the pending claims 28-41 and 42 are clearly distinguished over SINGHAL.

Further, the MMP 550 does not comprise a controller which transmits, to the cellular phone, first screen data configured to instruct the predetermined user of the

cellular phone to input a URL, since the MMP 550 does not transmit screen data to the client device, but receives data therefrom.

The MMP 550 also does not comprise a controller which receives, from the cellular phone, the screen data including the input URL, accesses a Web server based on the input URL, and obtains, from the accessed Web server, home page information corresponding to the input URL, since the MMP 550 merely receives the ACM from the client device. The ACM instructs the MMP 550 to detach, launch, and delete e-mail message attachments, but does not contain a URL input by the client device.

The MMP 550 additionally does not comprise a controller which transmits, to the selected printer, the obtained home page information, based on a printer address of the selected printer stored in the memory, the obtained home page information being printed by the selected printer, since SINGHAL does not disclose printing obtained home page information.

Thus, SINGHAL does not comply with recitations of the pending claims 43-45, and the pending claims 43-45 are clearly distinguished over SINGHAL.

Therefore, it is respectfully submitted that the features recited in Applicants' newly submitted claims 28-45 are not disclosed in SINGHAL cited by the Examiner.

The pending claims are also submitted to be patentable over the Examiner's proposed combination, since neither ELDRIDGE et al. nor SINGHAL, in any proper combination, disclose combinations of the features recited in Applicants' claims.

Moreover, the Examiner has not set forth any motivation for combining the teaching of ELDRIDGE et al. and SINGHAL. In particular, there is no reason to combine the system of ELDRIDGE et al., in which the token-enabled server 126

transmits paging message to a mobile computing device, with the system of SINGHAL, in which the MMP 550 receives (but does not transmit) the ACM from the client device. The MMP 550 and the ACM of SINGHAL function in an opposite manner to that of the token-enabled server 126 and the paging message of ELDRIDGE et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

# **SUMMARY AND CONCLUSION**

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have rewritten the objected to claims into independent form and have canceled the rejected claims and have submitted new claims for consideration by the Examiner. With respect to the new claims, Applicants have pointed out the features thereof and have contrasted the features of the new claims with the disclosure of the references individually and in the proposed combination.

Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

Applicants have also revised the Abstract and specification and submitted a replacement figure for entry to overcome the noted objections.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted, Shinichi WATANABE et al.

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**AMENDMENT TO THE DRAWINGS** 

The attached sheet of drawings includes a change to Fig. 3. The attached sheet

replaces the original sheet. The change made to Fig. 3 is as follows:

Fig.3 has been amended to correct a legend "Document Registering Apricution"

to "Document Registering Application".

Attachment: A Replacement Sheet